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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/807,693 | 03/24/2004 | Hiroshi Nakata | 1052-04 | 4406 |

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| EXAMINER | |
|---|---|
| ALEXANDER, MICHAEL P | |
| **ART UNIT** | **PAPER NUMBER** |
| 1742 | |

DATE MAILED: 09/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 10/807,693 | NAKATA ET AL. | |
| | Examiner | Art Unit | |
| | Michael P. Alexander | 1742 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☐ Responsive to communication(s) filed on *19 June 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-16* is/are pending in the application.

4a) Of the above claim(s) *9-16* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) *1-8* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *24 March 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *19 June 2004*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

## DETAILED ACTION

### *Election/Restrictions*

Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-8, drawn to a hot-rolled steel strip, classified in class 420, subclass 83.

II. Claims 9-16, drawn to a method for manufacturing a hot-rolled steel strip, classified in class 428, subclass 544.

The inventions are distinct, each from the other because of the following reasons:

Inventions II and I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product as claimed can be made by heating a steel stab to a temperature above about 1300 degrees C or below about 1000 degrees C or by completing the finish rolling at a temperature above about $Ar_3 - 50$ degrees C or more.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

During a telephone conversation with Dan Christenbury on 15 August 2005 a provisional election was made without traverse to prosecute the invention of Group I, claims 1-8. Affirmation of this election must be made by applicant in replying to this

Office action. Claims 9-16 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Okada et al. (U.S. Pat. 5,948,183).

Regarding claim 1, Okada et al. disclose (cols. 3-12) a hot-rolled steel strip having superior low temperature toughness and weldability for a high strength electric resistance welding pipe, comprising: on a mass percent basis, 0.005-0.30 C; 1.5% or less Si; 1.5% or less Manganese; 0.005 to 0.10 % Al; 0.25% or less Nb; 0.10% or less V; 0.20% or less Ti; 0.020% or less P; 0.015% or less S; 0.0100% or less N; 2.0% or

less Cu; 1.5% or less Ni; and 1.0% or less Mo; the balance being Fe and incidental impurities, and the hot-rolled strip is composed of entirely bainitic ferrite.

Still regarding claim 1, Okada et al. disclose C, Al and P compositional ranges that lie within the applicant claimed ranges. Okada et al. only specify the Si, Mn, Nb, V, Ti, P, S, Cu, Ni and Mo compositional ranges that overlap with the claimed invention, and Okada et al. do not specify the use of the claimed compositional formula.

With respect to the Si, Mn, Nb, V, Ti, P, S, Cu, Ni and Mo compositional ranges in claim 1, it has been held that when the claimed range lies within or overlaps that of the prior art, it is prima facie evidence of obviousness. See MPEP 2144.05 I. It would have been obvious to one of ordinary skill in the art to select the desired amount of Si, Mn, Nb, V, Ti, P, S, Cu, Ni and Mo from the compositional ranges disclosed by Okada et al. because Okada et al. disclose the same utility within the disclosed range.

With respect to the claimed compositional formula in claim 1, it is well settled that there is no invention in the discovery of a general formula if it covers a composition described in the prior art, In re Cooper and Foley 1943 C.D. 357, 553 O.G. 177; 57 USPQ 117, Takalatwalla v. Marburg, 620 O.G. 685, 1949 C.D. 77, and In re Pilling, 403 O.G. 513, 44 F(2) 878, 1931 C.D. 75. In the absence of evidence to the contrary, the selection of the proportions of elements would appear to require no more than routine investigation by those ordinary skilled in the art. In re Austin, et al., 149 USPQ 685, 688. It would have been obvious to one of ordinary skill in the art to select alloys within the claimed compositional ranges from the compositional range of Okada et al. because Okada et al. disclose the same utility throughout the disclosed range.

Regarding claim 2, Okada et al. do not specify the ratio in percent of the amount of precipitated Nb to the total amount of Nb would be from 5 to about 80%. However, Okada et al. disclose (col. 7 lines 4-18) using a coiling temperature of 550-700 degrees C, which would inherently produce a ratio in percent of the amount of precipitated Nb to the total amount of Nb of from 5 to about 80%.

Regarding claims 3-4, Okada et al. disclose (col. 6 lines 23-30) further comprising 0.005% or less of Ca.

Regarding claims 5-8, Okada et al. disclose (col. 5 lines 59-60) further comprising 0.0005-0050% B. With respect to the formula, it is well settled that there is no invention in the discovery of a general formula if it covers a composition described in the prior art, In re Cooper and Foley 1943 C.D. 357, 553 O.G. 177; 57 USPQ 117, Takalatwalla v. Marburg, 620 O.G. 685, 1949 C.D. 77, and In re Pilling, 403 O.G. 513, 44 F(2) 878, 1931 C.D. 75. In the absence of evidence to the contrary, the selection of the proportions of elements would appear to require no more than routine investigation by those ordinary skilled in the art. In re Austin, et al., 149 USPQ 685, 688. It would have been obvious to one of ordinary skill in the art to select alloys within the claimed compositional ranges from the compositional range of Okada et al. because Okada et al. disclose the same utility throughout the disclosed range.

***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA

1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-8 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 4 of copending Application No. 11/049836. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 4 of the '836 application teaches all the limitations of claims 1-8 including that the (1) the compositional ranges overlap with those of the instant application, (2) the compositional formula is the same as the instant application, (3) the bainitic phase is 95 percent, (4) and the niobium precipitate has a ratio of from 5 to about 80%. Therefore, a hot-rolled steel sheet having the composition and microstructure as recited in claims 1-8 would be obvious to one of ordinary skill in the art from what is recited in claim 4 of the '836 application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael P. Alexander whose telephone number is 571-272-8558. The examiner can normally be reached on M-F 8:30-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy V. King can be reached on 571-272-1244. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 571-273-8300 (toll-free).

mpa

GEORGE WYSZOMIERSKI
PRIMARY EXAMINER
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